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RICHARD SAMUEL
FRIEDMAN SIEGELBAUM, LLP
SEVEN BECKER FARM ROAD
ROSELAND NJ 07068

MM92/0420

EXAMINER

GIBSON.R

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 04/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action SummaryApplication No.
09/261,362

Applicant(s)

Saigo

Examiner

Randy Gibson

Group Art Unit

2859☒ Responsive to communication(s) filed on Apr 10, 2000☒ This action is **FINAL**.☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims☒ Claim(s) 1-11 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.☒ Claim(s) 1-11 is/are rejected.☐ Claim(s) _____ is/are objected to.☐ Claims _____ are subject to restriction or election requirement.**Application Papers**☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.☐ The drawing(s) filed on _____ is/are objected to by the Examiner.☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.☐ The specification is objected to by the Examiner.☐ The oath or declaration is objected to by the Examiner.**Priority under 35 U.S.C. § 119**☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been☐ received.☐ received in Application No. (Series Code/Serial Number) _____.☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).**Attachment(s)**☒ Notice of References Cited, PTO-892☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____☐ Interview Summary, PTO-413☐ Notice of Draftsperson's Patent Drawing Review, PTO-948☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-11 have been considered but are moot in view of the new ground(s) of rejection. However, some of applicant's remarks are general in nature and are addressed below.

The applicant notes that all of the 103 rejections in the last office action require a plurality of references since no one reference shows the subject matter now claimed. This statement by the applicant amounts to a truism since practically any rejection under 35 USC § 103(a) requires a plurality of references, otherwise it would be a rejection under section 102 instead (look at the plain language of the respective statutes and it is easy to see why). With all due respect, it is not understood what point the applicant is trying to make by stating the obvious (no pun intended).

In case the applicant is trying to argue that the examiner has combined an excessive number of references, it has been held reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

The applicant states that the examiner has conceded that applicant's device as now claimed is novel; this point may be true, but it is irrelevant. Once again, it is not understood what point the applicant is trying to make by stating the obvious. In order to obtain a patent, the device claimed must be both novel and non-obvious. Mere novelty under 35 USC § 102 is not in itself evidence of non-obviousness under section 103. See *Graham v John Deere*, 383 U.S. 1, 148 USPQ 459 (1966).

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motive to combine the references is clearly articulated in the rejection below. These motivation to combine the references stated in the 103 rejection below is essentially the same motivational statements made in the 103 rejections in the original office action. The examiner notes that the applicant has made no attempt to address the examiner's arguments in his response; the applicant simply engaged in an analysis of what was lacking from each individual reference without rebutting the examiner's arguments as to why one of ordinary skill in the art would have combined the references to remove these individual deficiencies. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The applicant points out that the reference to Hammett does not expressly teach using the flexible potentiometer contained in the bed sheet disclosed to actually monitor weight and has amended claim 1 to recite this feature. The reference to Langford et al has been newly cited by the examiner to address this argument. The examiner disagrees that Hammett teaches away from the device now claimed and he respectfully requests the applicant to point to the specific language in the reference that the applicant is referring to support his arguments.

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Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 8, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammett in view of Berger et al and Langford et al. Hammett shows flexible potentiometers (27) placed in a bed sheet which change in resistance when compressed (Col. 3, 67 to col. 4, ln. 23). Hammett does not expressly monitor for changes in weight (he simply detects movement by detecting which strip has weight applied to it), nor does he use a signal indicative of a patient's instantaneous weight to control a system supplying medicine to a patient. Berger et al teach that it is known that actually measuring the patient's instantaneous changes in weight provide for better patient monitoring and health (Col. 1, ln.s 10-59). Langford et al show that it is known in the weighing art that the flexible variable resistance strips of the kind used by Hammett can be used to monitor instantaneous weight of a person simply by reprogramming the monitoring microprocessor so that it detects the actual weight of a person supported thereon, not just the presence or absence of a person (Col. 2, ln.s 47-67; Col. 3, ln.s 31-48). It would have been obvious to one of ordinary skill in the art to use the sheet of Hammett to detect the instantaneous weighing weight of a patient, as taught by Langford et al, for the motive of to insuring patient safety, as suggested by Berger et al.

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4. Claims 5-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hammett in view of Berger et al and Langford et al as applied to claims 1-4, 8, 9, and 11 above, and further in view of Swersey. The aforementioned combination shows a system for monitoring the weight of a patient but does not indicate what the weight reading is to be used for. Swersey teaches that it is known to use a signal indicative of a patient's instantaneous weight to control a system supplying medicine to a patient (Col. 3, lns 24-55). It would have been obvious to one of ordinary skill in the art to use the weighing device of the aforementioned combination in a system for dispensing medicine, as taught by Swersey, to insure patient safety.

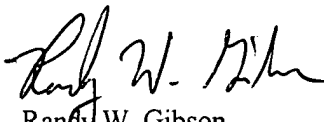
Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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6. Any inquiry concerning this communication should be directed to R. Gibson whose telephone number is (703) 308-1765. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego Gutierrez, can be reached on (703) 308-3875. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-7722. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



Randy W. Gibson
Primary Examiner
April 19, 2000